

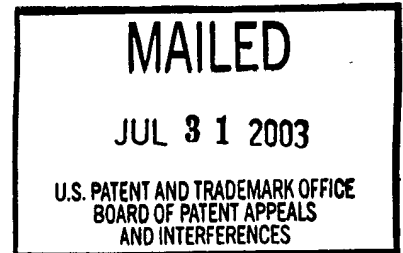
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte NORIO MIURA,
NOBORU YAMAZOE, and
TAIZO UDA

Appeal No. 2002-0324
Application No. 08/985,007

ON BRIEF



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Wolfe
39482

Before WINTERS, WILLIAM F. SMITH, and GRIMES, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 14 through 27. Claim 13, which is the only other claim remaining in the application, stands withdrawn from further consideration by the examiner as directed to a non-elected invention.

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(212) 940-8554

Representative Claims

Claims 14, 22, and 24, which are illustrative of the subject matter on appeal, read as follows:

14. An apparatus for measuring a medical substance contained in a sample using a resonance phenomenon resonating with an evanescent wave, said apparatus, comprising:

a resonance phenomenon generating section having a resonance material; and

a detecting means for detecting a change of an incident light which is made incident upon said resonance material to generate said resonance phenomenon or a change of a reflected light thereof; and

wherein the medical substance to be measured is fixed to said resonance material as an antigen.

22. A medical substance sensor for use in an apparatus for measuring a medical substance contained in a sample using a resonance phenomenon resonating with an evanescent wave comprising a resonance material where a resonance phenomenon is caused to resonate with an evanescent wave, wherein the medical substance to be measured is fixed to said resonance material as an antigen.

24. A method for measuring a medical substance contained in a sample using a resonance phenomenon resonating with an evanescent wave, said method comprising the steps of:

fixing a medical substance to be measured to a resonance material wherein a resonance phenomenon is caused to resonate with an evanescent wave as an antigen;

mixing an antibody which is coupled with said fixed medical substance in a specific manner to said sample;

bringing the mixture in contact with the resonance material to which said medical substance has been fixed;

making a light incident upon said resonance material;

detecting a change of the incident light or a change of a reflected light thereof when said resonance phenomenon is generated; and

recognizing an amount of medical substance contained in said sample on the basis of said change of the incident light or the reflected light.

The Prior Art References

The examiner relies on the following prior art references:

Batchelder et al. (Batchelder)	4,844,613	Jul. 4, 1989
Finlan et al. (Finlan '278)	4,997,278	Mar. 5, 1991
Finlan et al. (Finlan '213)	5,047,213	Sep. 10, 1991
Stewart	5,229,833	Jul. 20, 1993

The Rejections

Claims 14 through 27 stand rejected under 35 U.S.C. § 112, second paragraph, as not particularly pointing out and distinctly claiming the subject matter which applicants regard as their invention.

Claims 14, 15, 17, 19, 22, 24, 25, and 27 stand rejected under 35 U.S.C. § 102(b) as described by any one of the following references: Batchelder or Finlan '278 or Finlan '213.

Claims 14, 16, 22, and 24 stand rejected under 35 U.S.C. § 102(b) as described by Stewart.

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including Figures 1 through 12 and all of the claims on appeal; (2) applicants' Appeal Brief received January 3, 2001 (Paper No. 22); (3) the Final Rejection mailed August 17, 1999 (Paper No. 10); (4) the Examiner's Answer mailed April 26, 2001 (Paper No. 23); and (5) the above-cited prior art references.

On consideration of the record, including the above-listed materials, we affirm the rejection of claims 24 and 25 under 35 U.S.C. § 112, second paragraph, as indefinite. However, we reverse the rejection of all remaining claims under 35 U.S.C. § 112, second paragraph; and we reverse all of the rejections under 35 U.S.C. § 102(b).

Procedure

In the Final Rejection (Paper No. 10), page 2, the examiner objected to applicants' drawings under 37 CFR § 1.83(a). In their Appeal Brief (Paper No. 22), page 6, applicants argue that "the objection to the drawings should be withdrawn."

Applicants' position to the contrary, notwithstanding, the propriety of an examiner's objection to drawings does not constitute an appealable issue. As stated in In re Hengehold, 440 F.2d 1395, 1404, 169 USPQ 473, 479 (CCPA 1971):

There are a host of various kinds of decisions an examiner makes in the examination proceeding -- mostly matters of a discretionary, procedural or nonsubstantive nature -- which have not been and are not now

appealable to the board or to this court when they are not directly connected with the merits of issues involving rejections of claims, but traditionally have been settled by petition to the Commissioner. [footnote omitted]

Whether the examiner erred in objecting to applicants' drawings constitutes a petitionable, not appealable, question and we have no authority to review that question on appeal.

Section 112, paragraph 2

For the most part, we disagree with the examiner's assessment that applicants' claims are not sufficiently definite and, for that reason, fail to comply with 35 U.S.C. § 112, second paragraph. On reflection, however, we conclude that claims 24 and 25 do not "set out and circumscribe a particular area with a reasonable degree of precision and particularity." In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

The second manipulative step recited in claim 24 reads as follows: "mixing an antibody which is coupled with said fixed medical substance in a specific manner to said sample." Simply stated, applicants' syntax is unclear; and, accordingly, the metes and bounds of the claim are unclear. As best we can judge, applicants mean to say or intend to say the following: "mixing an antibody, which is capable of binding specifically to the fixed medical substance, with said sample." As it stands, the language of claim 24 does not express what is apparently intended and we shall sustain the examiner's rejection of this claim. Dependent claim 25, which includes all the limitations of

independent claim 24, falls for the same reasons. As stated in In re Zletz, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), "[a]n essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process." On this record, we conclude that the second manipulative step recited in claim 24 is not "precise, clear, correct, and unambiguous;" accordingly, we affirm the rejection of claims 24 and 25 under 35 U.S.C. § 112, second paragraph.

With respect to the remaining criticisms lodged against applicants' claims for indefiniteness, we shall not belabor the record with extensive commentary because, in our judgment, the examiner's position lacks merit. In particular, we invite attention to the last clause in claims 14 and 22 which reads "wherein the medical substance to be measured is fixed to said resonance material as an antigen." That clause reasonably apprises persons skilled in the art that (1) the medical substance to be measured is no different from the "medical substance contained in a sample" recited in the preamble of claims 14 and 22; (2) the medical substance to be measured is an antigen; and (3) the medical substance to be measured (antigen) is fixed to the resonance material in applicants' claimed apparatus or sensor. See Amgen Inc. v. Chugai Pharmaceutical Co., 927 F.2d 1200, 1217, 18 USPQ2d 1016, 1030 (Fed. Cir. 1991) (claims must reasonably apprise those skilled in the art their scope, and be as precise as the subject matter permits). By the same token, we conclude that the first manipulative step recited

in claim 24 is not indefinite. Accordingly, we reverse the rejection of claims 14 through 23, 26, and 27 under 35 U.S.C. § 112, second paragraph.

Section 102(b)

For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 677, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988). That is not the case here.

Independent claim 24 recites, as a first manipulative step, "fixing a medical substance to be measured to a resonance material wherein a resonance phenomenon is caused to resonate with an evanescent wave as an antigen." In other words, the medical substance to be measured is an antigen and applicants recite fixing that antigen to a resonance material. The examiner's position to the contrary, notwithstanding (Paper No. 23, page 10, lines 1 and 2), independent method claim 24 requires the step of fixing a medical substance to be measured (antigen) to a resonance material. By the same token, independent claims 14 and 22 recite "wherein the medical substance to be measured is fixed to said resonance material as an antigen." Again, these claims require that the medical substance to be measured (antigen) is fixed to applicants' resonance material.

Each prior art reference relied on by the examiner discloses a layer of antibody, not antigen, fixed to a resonance material. As correctly pointed out by applicants, neither Batchelder nor Finlan '278 nor Finlan '213 nor Stewart discloses the distinctive

feature of the claimed invention, viz., that antigen be fixed on the resonance material.

Accordingly, we reverse each of the examiner's rejections under 35 U.S.C. § 102(b).

Other Issue

One further matter warrants attention. It would appear that claim 20, line 3, inadvertently omits the word "surface." That is, applicants recite "a thin metal film directly or indirectly formed on one of said prism as said resonance material" whereas, apparently, the recitation should be "a thin metal film directly or indirectly formed on one surface of said prism as said resonance material." On return of this application to the examining corps, we recommend that applicants and the examiner correct this apparent, inadvertent error.

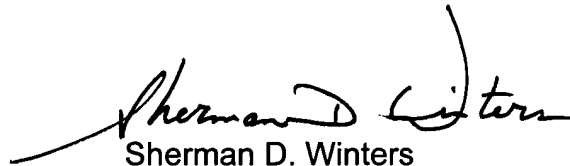
Conclusion

In conclusion, we have no authority to review the question whether the examiner erred in objecting to applicants' drawings. For the reasons set forth in the body of this opinion, we affirm the rejection of claims 24 and 25 under 35 U.S.C. § 112, second paragraph, as not sufficiently definite. However, we reverse the rejection of all remaining claims under 35 U.S.C. § 112, second paragraph; and we reverse all of the rejections under 35 U.S.C. § 102(b). We also invite attention to an apparent inadvertent error in claim 20, line 3.

The examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART


Sherman D. Winters
Administrative Patent Judge


William F. Smith
Administrative Patent Judge


Eric Grimes
Administrative Patent Judge

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Rosenman & Conlin, LLP
575 Madison Avenue
New York, NY 10022-2585

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